

Attorney Docket No.: **RTSP-0100**  
Inventors: **Monia and Cowsert**  
Serial No.: **09/763,748**  
Filing Date: **May 29, 2001**  
Page 3

**REMARKS**

Claims 1, 2 and 5-8 are pending in the instant application. Claims 1, 2 and 5-8 have been rejected. Claim 1 has been amended. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

**I. Rejection of Claims Under 35 U.S.C. 103(a)**

The rejection of claims 1, 2 and 5-8 under 35 U.S.C. 103(a) as being unpatentable over Goeddel et al. (US Patent 5,563,039) in view of Froehler (US Patent 5,256,775) has been maintained. The Examiner suggests that it would have been *prima facie* obvious to one of ordinary skill to make antisense sequences as taught by Goeddel et al., and to modify them as taught by Froehler et al. Further, the Examiner suggests one of skill would have been motivated because Goeddel teach that inhibition of TRADD may inhibit undesirable cell growth, such as cancer. The Examiner suggests that the reasonable expectation of success is provided by these references as well. Applicants respectfully traverse this rejection.

Attorney Docket No.: RTSP-0100  
Inventors: Monia and Cowsert  
Serial No.: 09/763,748  
Filing Date: May 29, 2001  
Page 4

At the outset, Applicants have amended claim 1, and by dependency claims 2 and 5-8, to recite that the antisense compounds are targeted to the coding region of human TRADD (SEQ ID NO: 1) and inhibit expression of human TRADD by at least 10% in T-24 cells. Support for this amendment to the claims can be found at pages 43-56 of the specification as filed.

As discussed in the previous response dated January 27, 2003, Goeddel et al. (US Patent 5,563,039) disclose antisense compounds in general and their use to inhibit expression of TRADD. Nowhere does this patent, either alone or when combined with the other cited reference, teach or suggest the antisense compounds as now claimed. It is only with the specification in hand that one of skill would understand that the claimed region could be successfully targeted with antisense and result in inhibition of gene expression.

The secondary reference cited fails to overcome the deficiencies in teaching of the primary reference.

Froehler (US Patent 5,256,775) disclose a general modification of antisense compounds with sugar and internucleoside linkages. Nowhere does this patent teach or suggest the antisense compounds

Attorney Docket No.: RTSP-0100  
Inventors: Monia and Cowsert  
Serial No.: 09/763,748  
Filing Date: May 29, 2001  
Page 5

targeted to the coding region of a human TRADD nucleic acid molecule as claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art must teach or suggest all claim limitations. Clearly, the combination of prior art cited fails to teach or suggest the limitations of the claims as amended, which claim antisense compounds targeted to a specific region within the sequence of human TRADD of SEQ ID NO: 1, and thus cannot render the instant claimed invention obvious. It is only with the specification in hand that one of skill would understand that the claimed region could be targeted with antisense compounds and result in inhibition of gene expression. Therefore, an expectation of success is only provided by the teaching of the specification as filed.

Attorney Docket No.: RTSP-0100  
Inventors: Monia and Cowser  
Serial No.: 09/763,748  
Filing Date: May 29, 2001  
Page 6

**II. Conclusion**

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

*Jane Massey Licata*

Jane Massey Licata  
Registration No. 32,257

Date: June 2, 2003

Licata & Tyrrell P.C.  
66 E. Main Street  
Marlton, NJ 08053

856-810-1515